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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,492	07/30/2003	Hieronymus Andriessen	223591	9668

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EXAMINER
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XU, LING X

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/630,492	<b>Applicant(s)</b> ANDRIESEN, HIERONYMUS	
	<b>Examiner</b> Ling X. Xu	<b>Art Unit</b> 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 9-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 15-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/30/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-8 and 15-31 on 10/21/2005 is acknowledged. The traversal is on the ground(s) that the Examiner would not be unduly burdened in the search for prior art relevant to each group due to the overlapping nature of the subject matter claimed. This is not found persuasive because Group I and II are directed to product and process, respectively. A search of the product claims may overlap the search of the method claims. However, a search of the product claimed does not include all the areas required for the search directed to the method. Accordingly, additional search is required for Group II and a serious burden does exist. In addition, the product and method claims are classified in two different classes and may be required to be examined by different groups of examiners with different expertise. Therefore, in order to ensure the prosecution quality, the product claims and method claims should be searched and examined separately.

Claims 9-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

2. The disclosure is objected to because of the following:

The Brief Description of the Drawing(s) is missing, *See* MPEP § 608.01(f) and 37 CFR 1.74. Appropriate correction is required.

### ***Abstract***

3. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it contains more than 150 words. Correction is required. See MPEP § 608.01(b).

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 and 15-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 11-20 of copending application No. 10/629,242. Although the conflicting claims are not identical, they are not patentably distinct from each other because the cited claims in the co-pending applications recite the nano-porous metal oxide semiconductor having the same band-gap sensitized on its internal and external surface with one or more metal chalcogenide, which including metal oxides, with the same band-gap of less than 2.9 eV as claimed in the present application. The claims in the copending application also recite that the porous metal oxide semiconductor comprising phosphoric acid or phosphate. Accordingly, the claims in the copending application anticipate the limitation recited in claims 1-8 and 15-31.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 1-8 and 15-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 12-22 and 25-29 (based on the amendment filed on 10/5/2005) of copending Application No. 10/628,618. Although the conflicting claims are not identical, they are not patentably distinct from each other because the cited claims in the co-pending applications recite the nano-porous metal oxide semiconductor having the same band-gap sensitized on its internal and external surface with one or more metal chalcogenide, which including metal oxides, with the same band-gap of less than 2.9 eV as claimed in the present application. The claims in the copending application also recite that the porous metal oxide semiconductor comprising phosphoric acid or phosphate.

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Accordingly, the claims in the copending application anticipate the limitation recited in claims 1-8 and 15-31.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-8, 15-18, 20-23, 25-26 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Yuji (JP-2001-261436, translation included).

With respect to claims 1-3, 7, 15-17, 21-23, 25-26 and 28, Yuji discloses a solar cell, one of the photovoltaic cells, comprising a porous metal oxide semiconductor such as titanium oxide and one or more inorganic sensitizer such as vanadium oxide on the internal and external surface of the porous metal oxide (page 2, embodiments [0022]-[0023]). Accordingly, Yuji discloses the use of the same porous metal oxide semiconductor and the same sensitizer in the solar cell as claimed, the same materials would also have properties such as band-gaps as claimed.

It is noted that claims 23, 26 and 28 are product-by-process claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps (MPEP 2113). “[E]ven though product – by process claims are limited by and defined by

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the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966.

With respect to claims 4 and 18, Yuji discloses that the amount of inorganic sensitizer is about 0.1-2.5 micromol to 1g of titanium oxide (page 7, embodiment [0077]). 1g of titanium oxide is equivalent to 0.0125 mol or 12.5 micromol of titanium oxide. Accordingly, the ratio of the inorganic sensitizer to the porous metal oxide semiconductor is in the range of 0.2 to 0.008 ( $0.1/12.5=0.008$  and  $2.5/12.5=0.2$ ) to 1, which meets the limitations of claims 4 and 18.


With respect to claims 6, 8 and 20-22, Yuji discloses that the particles size of the porous metal oxide may be 10nm (page 2, embodiment [0019], which indicates that the pore size of the metal oxide particles may be less than 10nm. The semiconductor metal oxide with pore size less than 10nm is considered nano-porous.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling X. Xu whose telephone number is 571-272-1546. The examiner can normally be reached on 8:00 - 4:30 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah D. Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ling X. Xu  
Primary Examiner  
Art Unit 1775

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